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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/021,706	02/10/98	WILEY	S 6048 US P1

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EXAMINER	
BRUSCA, J	
ART UNIT	PAPER NUMBER
1636	2

DATE MAILED:

05/06/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
09/021,706

Applicant(s)
Wiley

Examiner
John S. Brusca

Group Art Unit
1636



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-44 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, 29, 34, 37, 40, 43, and 44, drawn to Trepa genes, vectors comprising Trepa genes, cells comprising Trepa genes, methods of expressing Trepa genes, and methods of assay for Trepa genes, classified in class 536, subclass 23.5.
 - II. Claims 16-18, 20, 25, 26, 38, 39, and 41, drawn to Trepa proteins, classified in class 530, subclass 350.
 - III. Claims 24, 27, 28, 30, 31, and 42, drawn to antibodies specific for Trepa protein and their method of use in an assay of a Trepa protein, classified in class 424, subclass 172.1.
 - IV. Claim 21, drawn to a method of therapy comprising use of a compound that activates Trepa proteins, classified in class 514, subclass 2.
 - V. Claim 35, drawn to a method of making antibody specific for Trepa protein by use of Trepa protein, classified in class 424, subclass 172.1.
 - VI. Claim 36, drawn to a method of making an antibody specific for Trepa protein by use of a Trepa gene, classified in class 424, subclass 172.1.

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VII. Claims 32 and 33, drawn to a method of using Trepa protein to assay for antibodies specific for Trepa protein, classified in class 435, subclass 7.1.

VIII. Claim 23, drawn to a method of using Trepa protein to assay for Trepa protein receptors, classified in class 435, subclass 7.1.

IX. Claims 19 and 22, drawn to a method of assay of antagonists and agonists of Trepa protein and an antagonist of Trepa protein activity, classified in class 435, subclass 4.

2. The inventions are distinct, each from the other because of the following reasons:

3. The Trepa genes and their method of expression and assay of Invention I, the Trepa proteins of Invention 2, and the antibodies and their method of use of Invention III are patentably distinct because they are drawn to compounds that are biochemically and functionally distinct.

4. The Trepa genes and their method of expression and assay of Invention I are patentably distinct from the methods of Inventions IV, V, VII, VIII, and IX because the methods do not utilize Trepa genes.

5. Inventions I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the Trepa genes of Invention I could be used to express Trepa

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protein for purposes other than immunization, for example as a control in an assay for Trepa proteins or in an assay for Trepa specific antibodies.

6. The Trepa protein of Invention II is patentably distinct from the methods of Inventions IV, and VI because the methods do not utilize Trepa protein.

7. Inventions II and Inventions V, VII, VIII, and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the Trepa protein of Invention II could be used in any of the methods of Inventions V, VII, VIII, and IX.

8. The antibody specific for Trepa protein and its method of use of Invention III is patentably distinct from the methods of Inventions IV, VII, VIII, and IX because none of the methods require the use of the antibody of Invention III.

9. Inventions III and Inventions V and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the antibody of Invention III could be made by the method of Invention V or Invention VI.

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10. The methods of Inventions IV-IX are patentably distinct because all the methods utilize different steps or different compounds or produce different results.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reasons given above and the search required for Groups III, V, and VI are different, restriction for examination purposes as indicated is proper.

13. Because these inventions are distinct for the reasons given above and the search required for Group VII is not required for Group VIII, restriction for examination purposes as indicated is proper.

14. A telephone call was made to Cheryl Becker on 5/1/98 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

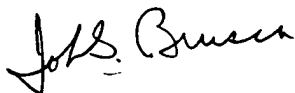
15. Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. For routine submissions the FAX number is (703) 308-4242. For FAX transmissions in cases in which the Examiner has been notified by phone to expect the transmission, the FAX number is (703) 305-7939. In such cases please call the Examiner at

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(703) 308-4231 at the time of transmission to expedite delivery of the fax. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, Ph.D., can be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



John S. Brusca, Ph.D.

Examiner